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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,632	05/02/2001	Ulrich Sander	LAGP:102_US_	6611

7590

10/21/2002

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,632

Applicant(s)

SANDER, ULRICH

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2002 and 29 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-11, 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 4-8, 12 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendments (Paper Nos. 7 and 9) of 6/12/2002 and 7/29/2002.

Specification

2. The lengthy specification which is amended by the amendments has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-3 and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kleinberg (U.S. Patent No. 5,155,509, of record).

See Kleinberg, columns 3-4 and figs. 2-3.

5. Claims 1, 3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kumiommi et al (U.S. Patent No. 4,209,225).

Kumiommi et al disclose an optical system for observing a patient's eye. The optical system comprises an illuminating system having a light source and a plurality of optical elements disposed in the illuminating light path from the light source to a patient's eye. The lens elements (1,2,3) constituting the optical system allow the light come to a focus point (P). In columns 2-3, in particular,

need explain
1-3, 6, 7, 8, 9
11
12
13

column 3, the tube (4) supporting the lens elements (1-3) is able to move in relation to the imagine lens (5) and also with the patient's eye. As such, a movement of the tube supporting the lens elements (1-3) with respect to the patient's eye will make the patient's eye out-of-focus with respect to the focus point (P).

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinberg (of record).

Kleinberg discloses a microscope having an illuminating apparatus for illuminating a patient's eye. The illuminating system comprises a module having a set of mirrors (38 and 42) which module is able to slide into the illuminating path and remove therefrom. In the system shown in figure 3, the whole assembly contained mirrors (38,42) is located in the illumination path provided by the source (28) which provides a light beam passing through a portion of the objective lens (16). The light passed through the lens (16) will reflect from the mirrors (38 and 42) and come into a particular point/area of the patient's eye on the right side of the eye with respect to the axis (18). When the whole assembly contained mirrors (38,42) is removed from the illumination light path as shown in figure 2 then the light passed through the lens (16) will come to illuminate a different pint/area of the patient's eye. As such the point/area of the patient's eye

which is illuminated when the assembly is in the light path (figure 3) now will become darken (figure 2) because the light in the figure 3 does not illuminate such point/area of the patient's eye. The same result will occur when a user operate the pivotal mirror as described in the embodiment or description concerning the operation of the mirror shown in figure 9. In other words, an operation of the pivotal mirror will make the previous illuminating spot/area become darken when the pivotal mirror is moved to different orientation. The only thing missing from the art of Kleinberg is that he does not explicitly state a method for adjusting the position of the illuminating light on the object. However, it would have been obvious to one skilled in the art at the time the invention was made to utilize the microscope provided by Kleinberg by setting forth a set of steps including the step of moving the module and/or pivoting the second mirror located inside the module for the purpose of adjusting the position of the focus point on the object and thus making one area of the object in a field of view become darken or brighten.

8. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumiomi et al.

Kumiomi et al disclose an optical system for observing a patient's eye. The optical system comprises an illuminating system having a light source and a plurality of optical elements disposed in the illuminating light path from the light source to a patient's eye. The lens elements (1,2,3) constituting the optical system allow the light come to a focus point (P). In columns 2-3, in particular,

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column 3, the tube (4) supporting the lens elements (1-3) is able to move in relation to the imagine lens (5) and also with the patient's eye. As such, a movement of the tube supporting the lens elements (1-3) with respect to the patient's eye will make the patient's eye out-of-focus with respect to the focus point (P). The only thing missing from the art of Kumiomi et al is that they do not explicitly state a method for adjusting the position of the illuminating light on the object. However, it would have been obvious to one skilled in the art at the time the invention was made to utilize the microscope provided by Kumiomi et al by setting forth a set of steps including the step of moving the tube supporting the lens elements for the purpose of adjusting the position of the focus point on the object and thus making one area of the object in a field of view become darken or brighten.

Response to Arguments

9. Applicant's arguments filed on 6/12/2002 have been fully considered but the following conclusions are made.

A) With regard to the rejection of claims 1, 3 and 10 under 35 USC 102(e) over the art of Engelhardt et al, the amendments to the claims and applicant's arguments are sufficient to overcome the art rejection. As such, the rejection is now withdrawn.

B) With regard to the rejection of claims 1-3 and 9 under 35 USC 102(b) over the art of Kleinberg, the amendments to the claims are not sufficient to overcome the rejection. It is noted that applicant's arguments filed on 6/12/2002 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., at least one of the plurality of optical components normal(ly) in the illumination path, the reduction in intensity occurs at the subject) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments that the art provided by Kleinberg does not disclose the features recited in the present claims. The Examiner respectfully disagrees and respectfully invited the applicant to review the art of Kleinberg, in particular, in columns 3-4 and figs. 2-3.

In the system shown in figure 3, the whole assembly contained mirrors (38,42) is located in the illumination path provided by the source (28) which provides a light beam passing through a portion of the objective lens (16). The light passed through the lens (16) will reflect from the mirrors (38 and 42) and come into a particular point/area of the patient's eye on the right side of the eye with respect to the axis (18). When the whole assembly contained mirrors (38,42) is removed from the illumination light path as shown in figure 2 then the light passed through the lens (16) will come to illuminate a different pint/area of the patient's eye. The same result will occur when a user operate the pivotal mirror as described in the embodiment or description concerning the operation of the mirror shown in figure 9. In other words, an operation of the pivotal mirror will make the previous

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illuminating spot/area become darken when the pivotal mirror is moved to different orientation. As such the point/area of the patient's eye which is illuminated when the assembly is in the light path (figure 3) now will become darken (figure 2) because the light in the figure 3 does not illuminate or brought into focus in such point/area of the patient's eye.

C) With regard to the rejection of claims 1-2 under 35 USC 102(b) over the art of Biber et al, the amendments to the claims and/or applicant's arguments are sufficient to overcome the rejection. As such, the rejection is now withdrawn.

D) With regard to the rejection of claims 1-2, 4 and 9 under 35 USC 102(b) over the art of Nakazaki et al, the amendments to the claims and/or applicant's arguments are sufficient to overcome the rejection. As such, the rejection is now withdrawn.

E) With regard to the rejections of claims under 35 USC 103(a) over the art of Engelhardt et al or Biber et al or Nakazeki et al, the amendments to the claims and/or applicant's arguments are persuasive; therefore, the rejections are withdrawn. With regard to the rejection of claims 11 and 14 under 35 USC 103(a) over the art of Kleinberg, the amendments to the claims and applicant's arguments are not sufficient to overcome the rejection.

It is noted that in the arguments against the rejection of claims 11 and 14 over the art of Kleinberg, since applicant has not provided any further specific arguments; therefore, the examiner's opinions provided in element B) of this section still applied.

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Allowabl Subj ct Matt r

10. Claims 4-8 and 12-13 are objected to as being dependent upon a rejected base claim, but would be allowable if each of claims 4-6 and 12-13 is rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

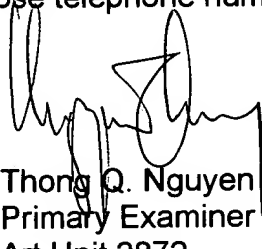
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is 703 308 4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703 308 1687. The fax phone

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numbers for the organization where this application or proceeding is assigned are 703 308 7724 for regular communications and 703 308 7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
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October 15, 2002